



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)
Sanatgar, Homayoun, et al.) Group Art Unit: 3632
Serial No.: 10/601,110) Examiner: King, Anita M.
Filed: June 23, 2003) Confirmation No.: 7024
For: METAL TUBE SUPPORT) Customer No.: 34026
BRACKET AND METHOD FOR) Previous Docket No. 012903
SUPPORTING A METAL TUBE) New Docket No. 094996-155036
Attorney Handling Renewed Petition:
Paul Shanoski, Senior Attorney
Office of Petitions

**RENEWED PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Mail Stop Petition
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The above-identified application became abandoned for failure to file a timely and proper reply to the Office Action mailed September 27, 2004. On November 21, 2007, Applicant filed a Petition for Revival of this unintentionally abandoned application. On February 19, 2008, the Patent Office mailed its Decision on Petition Under 37 C.F.R. § 1.137(b) ("Decision") indicating

CERTIFICATE OF MAILING (37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to Mail Stop Petition, Commissioner for Patents, USPTO, P.O. Box 1450, Alexandria, VA 22313-1450.

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July 18, 2008

Date of Deposit

Yolanda G. Ybuan

Name of Person Mailing Paper

Signature of Person Mailing Paper

that a Renewed Petition in reply, addressing each of the points in the Decision, was allowed.

The attorney handling this matter is Paul Shanoski, Senior Attorney, Office of Petitions.

Accordingly, Applicant hereby files this Renewed Petition under 37 C.F.R. § 1.137(b).

1. Petition Fee

Applicant is other than a small entity. The original fee due for the original Petition was \$1,540.00 under 37 C.F.R. § 1.17(m), and Deposit Account No. **50-2468** was charged in the amount of \$1,540.00 to cover the Petition fee. Further, please charge Deposit Account No. **50-2468** for any other or additional fees that may be due with the submission of this paper.

2. Reply

A reply to the October 1, 2004 Office Action, previously filed on November 21, 2007, was previously filed with the original Petition.

3. Terminal Disclaimer

Since this utility application was filed on or after June 8, 1995, no terminal disclaimer is required.

4. Statement

In response to the Decision on Petition Under 37 C.F.R. § 1.137(b) ("Decision") mailed February 19, 2008, Applicant Thermal Dynamics, Inc. ("Thermal Dynamics") hereby files this Renewed Petition for Revival Of An Application For Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) ("Renewed Petition").¹ Declarations in support of this Renewed Petition are provided by Homayoun Sanatgar (the first named-inventor) in the present application, Neil Holt (a named-inventor), David A. Randall (attorney for Thermal Dynamics filing the original Petition), and Lawrence R. LaPorte (attorney for Thermal Dynamics filing the present Renewed

¹ The Decision on Petition, at pages 6 and 7, indicates that Petitioner Thermal Dynamics may file a "Renewed Petition" in reply.

Petition). As explained in the Declarations submitted by Messrs. Sanatgar, Holt and LaPorte, named-inventors Behnam Akbarian, Gary Johnson and Don Smith were all both unavailable and not involved in any manner with the on-going prosecution or later abandonment of the '110 application.

This Renewed Petition addresses each of the issues raised by the Office of Petitions in its Decision, including each of the time periods addressed in the Decision. The Declaration of Lawrence R. LaPorte, the attorney for Thermal Dynamics who met with Mr. Appel, reports on the written and oral communications with attorney of record Gary Appel, including Mr. LaPorte's numerous attempts to obtain Mr. Appel's cooperation and Mr. Appel's statements made to Mr. LaPorte with regard to the abandonment of the above application.

Based on the attached declarations, it is plain that the above patent application was abandoned unintentionally under 37 C.F.R. § 1.137(b) and corresponding case law. The errors and/or omissions by attorney of record Gary Appel in the form of his failure to respond to the outstanding Office Action are the sole cause of the abandonment of the above patent application. As set forth in the Second Declaration of Homayoun Sanatgar, it was Mr. Appel alone who received the second Office Action dated September 27, 2004 and failed to timely respond. To compound matters, Mr. Appel failed to inform Thermal Dynamics of the abandonment of the '110 application.

Thermal Dynamics has been diligent in all phases of the patent application, including the initial prosecution of the patent application, the petition for revival, and the present renewed petition for revival. If not for the mistakes of Mr. Appel, the '110 application would not have become abandoned. The mistakes of Mr. Appel should not be attributed to Thermal Dynamics, nor should they undermine the diligence of Thermal Dynamics. Mr. Appel is solely at fault in

not replying to the second Office Action, not filing a petition to revive the patent application, and not notifying Thermal Dynamics that the patent application had been abandoned. Accordingly, Thermal Dynamics should not be punished for that which it had no notice and bears no fault.

Thermal Dynamics Diligently Pursued The Present Application And Did Not Learn of its Abandonment Until Early 2007

The Decision cites *In re Application of G* for the rule that a petitioner is required to establish that the delay in prosecuting a patent was unintentional when there is a question whether the delay was unintentional. In re Application of G, 11 U.S.P.Q. 2d 1378, 1380 (Comm'r Pats. 1989). When applied to the present case, however, *In re Application of G* is inapposite. There, the petitioner *intentionally* abandoned their patent application after mistakenly concluding that the subject matter of the patent was not patentable. Id. at 1379. In contrast, the present application was not deliberately abandoned by applicant, and, when the abandonment was discovered, applicant diligently pursued revival of the patent application.

In a case on point with regard to the present situation, In re Application of Robert Lonardo, 17 U.S.P.Q. 2d 1455 (Comm'r Pats. 1990), the Deputy Assistant Commissioner for Patents revived a patent that had been abandoned for fourteen (14) years due to unavoidable delay. *In Lonardo*, the patent application became abandoned on March 8, 1974, after the prosecuting attorney failed to respond to the Patent Office in a timely manner. Id. Fourteen (14) years passed before the applicant learned that his attorney's lack of diligence caused the patent application to become abandoned. Id. The ill health of the prosecuting attorney was determined to be, at least in part, the cause of the failure to file a response, and the delay was therefore excused as unavoidable. Id. at 1459.

The Deputy Assistant Commissioner found that reliance upon another, *i.e.*, the attorney of record, to carry out the prosecution of the patent application did not undermine the applicant's

diligence, as the applicant had no reason not to rely upon the patent attorney. *Id.* at 1457. *See also* Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430 (E.D. Va. 1988) (applicant found to be diligent despite their reliance upon another party, with whom they had a contract, to prosecute their patent). Accordingly, when the attorney of record acts to intentionally conceal his mistake, as did the attorney in *Lonardo*, the mistake of the attorney cannot be charged to the client. In re Application of Robert Lonardo, 17 U.S.P.Q. 2d at 1458. Thus, after fourteen (14) years of delay, the applicant's renewed petition to revive filed on June 1, 1990 was granted. *Id.* at 1455.

The current case presents similar, if not significantly less egregious facts. Here, Mr. Appel suggested by his comments to counsel that his illness played a role in his failure to respond to the Patent Office in a timely manner (Declaration of Lawrence R. LaPorte ("LaPorte Decl.") ¶ 5.) Moreover, the application here was unintentionally abandoned for a significantly shorter period of time, two years and seven months versus fourteen years before the filing of a petition to revive. Further, the patent application in *Lonardo* was revived under the more stringent standard of 37 CFR 1.137(a) for "unavoidable delay" rather than the less demanding "unintentionally abandoned" standard. *See* Manual of Patent Examining Procedure, which states: "[s]ince the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to be grantable as filed than is a petition under 37 CFR 1.137(b)." Manual of Patent Examining Procedure 711.03(c)(II)(C).

Just as in *Lonardo*, the applicant here was justified in relying upon the attorney of record to prosecute the patent application. Prior to the abandonment of the '110 application, Mr. Appel had done nothing to demonstrate to Thermal Dynamics that he was not diligent or trustworthy. Mr. Appel had competently handled all of Thermal Dynamics' new patent applications since

about the year 2000. (Second Declaration of Homayoun Sanatgar ("Sanatgar Decl.") ¶ 3.) At least two of those patent applications had resulted in issued patents for Thermal Dynamics. (Id. at ¶ 3.) To the best of Mr. Sanatgar's knowledge, prior to the abandonment of the '110 application, Mr. Appel had timely prosecuted all of Thermals Dynamics' patent applications. (Id.)

Prior to discovering the abandonment of the '110 application, Mr. Sanatgar understood, consistent with their previous practices and understanding, that Mr. Appel was responsible for diligently handling the prosecution of the '110 application. (Id. at ¶ 5.) Furthermore, Mr. Sanatgar believed that Mr. Appel would notify him of any important matters regarding Thermal Dynamics' patent cases. (Id.) For example, Mr. Appel forwarded his June 28, 2004 Response to the first Office Action for the '110 application to Mr. Sanatgar. (Id.). Based on Mr. Appel's track record of diligently prosecuting patents for Thermal Dynamics, Mr. Sanatgar was justified in relying upon Mr. Appel to prosecute the '110 application. And, Mr. Sanatgar did in fact believe Mr. Appel was diligently handling Thermal Dynamics' patent cases. (Id.) In accordance with the belief that Mr. Appel was still diligently representing Thermal Dynamics, on February 7, 2005, Mr. Sanatgar sent Mr. Appel an attorney-client privileged facsimile regarding an unrelated third-party matter. (Id.)

Furthermore, the Declarations of Neil Holt and Mr. LaPorte filed herewith demonstrate that the other named inventors at Thermal Dynamics were justified in believing that Mr. Appel was diligently prosecuting the '110 application. Declarations could not be obtained from the other named inventors for various reasons. (LaPorte Decl. ¶ 9; Holt Decl. ¶¶ 2-3.) Behnam Akbarian has since left Thermal Dynamics and efforts to contact him were unsuccessful. (LaPorte Decl. ¶ 9.) Mr. LaPorte made numerous telephone call to Gary Johnson, but he

likewise did not return Mr. LaPorte's telephone calls. (Id.) Don Smith is currently on a long term assignment in mainland China and is unavailable. (Holt Decl. ¶ 3; LaPorte Decl. ¶ 9.) As explained below, none of the named inventors had any responsibility for interfacing with Mr. Appel other than Mr. Sanatgar.

Mr. Holt, a retired former employee of Thermal Dynamics and named inventor on the '110 application, managed and directed the personnel for a number of design and development projects, including the one that is the subject of the '110 application. (Holt Decl. ¶ 2.) Gary Johnson, the former President and Chief Executive Officer of Thermal Dynamics, assigned Mr. Holt the responsibility of selecting a Thermal Dynamics employee to act as a liaison to patent counsel Gary Appel. (Holt Decl. ¶ 3.) Neil Holt assigned Mr. Sanatgar sole responsibility for interfacing with Mr. Appel. (Id.) Thus, Messrs. Holt, Johnson, Akbarian, and Smith had no responsibility for interfacing with Mr. Appel, nor monitoring the status of the '110 application. (Holt Decl. ¶ 3; LaPorte Decl. ¶ 9.) In fact, Mr. Holt was not even aware the '110 application had become abandoned until contacted by Mr. LaPorte in connection with this renewed petition to revive. (Holt Decl. at ¶ 2.) Thus, only Mr. Sanatgar was responsible for interfacing with Mr. Appel.

And as in *Lonardo*, once Mr. Appel made his mistakes, they were apparently intentionally concealed from the applicant rather than immediately disclosed. Mr. Appel could have at any time notified Mr. Sanatgar, or anyone else at Thermal Dynamics, that a Second Office Action had issued, that he was not going to file a timely response, or that the '110 application had become abandoned, but he chose not to do so. (Sanatgar Decl. at ¶ 4.) Between early 2005 and the summer of 2006, Mr. Sanatgar traveled extensively to mainland China on business, which inhibited his ability to contact Mr. Appel. (Id. at ¶ 6.) During that time, Mr.

Sanatgar was completely unaware that the '110 application had become abandoned, or that a second Office Action had even issued. (Id.) In the summer of 2006, Mr. Appel had multiple opportunities to communicate this information to Thermal Dynamics, as Mr. Sanatgar made numerous telephone calls to Mr. Appel's office, but he declined to do so. (Id. at ¶ 7.)

Then, on September 5, 2006, Mr. Sanatgar sent Mr. Appel a certified letter that was delivered and received on September 8, 2006. (Id. at ¶ 7.) In response to the letter, Mr. Appel telephoned Mr. Sanatgar, at which time Mr. Sanatgar requested a summary of all of Thermal Dynamics' pending patent applications. (Id. at ¶ 8.) During that conversation, Mr. Appel mentioned that he had been unable to respond to Mr. Sanatgar due to serious illness, but made no mention of the second Office Action or the abandonment of the '110 application. (Id. at ¶ 8.) As a follow up to the telephone conversation, Mr. Appel sent Mr. Sanatgar a letter stating that he would send Mr. Sanatgar a "summary" of Thermal Dynamics' patent cases by September 17, 2006. (Id. at ¶ 8.) Based on the positive nature of the telephone conversation and follow-up letter, Mr. Sanatgar had no reason to believe that Mr. Appel had not timely handled all of Thermal Dynamics' patent cases. (Id. at ¶ 8.) When the summary had not arrived by September 20, 2006, Mr. Sanatgar telephoned Mr. Appel's office and left a message. (Id. at ¶ 9.) Mr. Sanatgar spoke with Mr. Appel by telephone on October 15, 2006. (Id. at ¶ 9.) Mr. Appel again claimed that he had been ill, and that he would provide the summary by October 19, 2006. (Id. at ¶ 9.) The summary did not arrive as promised. (Id. at ¶ 9.) As a result, Mr. Sanatgar made four (4) more telephone calls to Mr. Appel's office, each time leaving a message requesting Mr. Appel to contact Mr. Sanatgar. (Id. at ¶ 9.)

On November 14, 2006, Mr. Sanatgar sent a complaint regarding Mr. Appel to the State Bar of California. (Id. at ¶ 10.) Mr. Sanatgar received a response stating that Mr. Appel had

been advised to re-establish contact with Thermal Dynamics. (Id. at ¶ 11.) Having faith in the authority of the State Bar to compel Mr. Appel to cooperate, Mr. Sanatgar waited for a response. (Id. at ¶ 11.) No response came, however, and Mr. Sanatgar began to investigate the matter on his own in early 2007. (Id. at ¶ 13.)

Plainly, failure of Mr. Appel to respond to the second Office Action caused the ‘110 application to become abandoned, which Mr. Appel then tried to conceal through dilatory tactics and non-responsiveness. Based on the precedent set forth in *Lonardo* and *Futures*, patent applications that become abandoned as a result of the applicant’s reliance on another to diligently prosecute a patent application, such as the attorney of record, satisfy the requirements for unintentional abandonment. Mr. Appel’s mistakes should not be attributed to Thermal Dynamics because he apparently attempted to conceal his mistakes. Furthermore, Thermal Dynamics justifiably relied on Mr. Appel, an attorney who had successfully obtained patents for Thermal Dynamics, and who was previously diligent with respect to every aspect of the patent application up to the point of abandonment. Thus, the renewed petition here should be granted as it seeks revival under the more lenient standard of 37 CFR 1.137(b), and it comprises facts less egregious than those presented in *Lonardo*.

The Initial Petition Pursuant to 37 C.F.R. § 1.137(b) to Revive the Application was Diligently Filed After Thermal Dynamics Learned of the Abandonment

The Declarations by David A. Randall and Homayoun Sanatgar filed herewith demonstrate that Thermal Dynamics and its patent counsel were diligent in the preparation and filing of the original Petition For Revival of An Application For Patent Abandoned Unintentionally Under C.F.R. § 1.137(b). (Declaration of David A. Randall (“Randall Decl.”).) As described above, the actions of Mr. Appel resulted in the abandonment ‘110 application and prevented Mr. Sanatgar from discovering that abandonment. Only after Mr. Sanatgar conducted

his own investigation of Thermal Dynamics' pending patent cases, did he discover that the '110 application had become abandoned. (Sanatgar Decl. ¶ 12.)

After Mr. Sanatgar learned of the abandonment of the '110 application, he contacted patent attorney Michael Davidson, with whom he had worked previously on an unrelated matter. (*Id.* ¶ 13.) Mr. Sanatgar and Mr. Davidson had a general discussion regarding patent application abandonment and revival. (*Id.*) As a result of that discussion, and the recent experiences with sole practitioner Gary Appel, Mr. Sanatgar concluded it would be better for Thermal Dynamics to hire a larger law firm for revival of the '110 application. (*Id.*) During the time period after Mr. Sanatgar learned of the abandonment of the '110 application, however, Mr. Sanatgar duties at Thermal Dynamics required him to travel twice to mainland China in April and June, 2007. (*Id.*) Because Mr. Sanatgar's trips required several weeks of intensive preparation, and several weeks of time-consuming post trip follow up, Mr. Sanatgar was unable to contact alternative patent counsel until August 2007. (*Id.*)

As soon as Mr. Sanatgar's demanding schedule allowed, he contacted David A. Randall of the Jones Day law firm. (*Id.* ¶ 14.) From the time that Mr. Randall was first contacted by Mr. Sanatgar on August 10, 2007, through the filing of the petition to revive on November 21, 2007, Mr. Randall worked diligently with Mr. Sanatgar and patent agent Wang to revive the '110 application. (Randall Decl. ¶¶ 2-6; Sanatgar Decl. ¶ 14.)

Thermal Dynamics Has Diligently Pursued The Filing of The Instant Grantable Petition Pursuant to 37 C.F.R. 1.137(b) to Revive the Application

The Declaration by Lawrence R. LaPorte filed herewith demonstrates that Thermal Dynamics was diligent in procuring a grantable renewed petition to revive the '110 application. Further, as explained therein, Thermal Dynamics attempted to elicit the cooperation of Mr. Appeal for a declaration explaining the reasons for abandonment. (*Id.* at ¶¶ 3-7.) However, Mr.

Appel, for whatever reasons, has refused any further cooperation or contact. (Id.) Making every effort to comply with the request of the Examiner, Mr. LaPorte made numerous attempts throughout the allowed time for the renewed petition to communicate with Mr. Appel. (Id.) Despite his best efforts, Mr. LaPorte was unable to procure a declaration--or any clear answers--from Mr. Appel regarding Mr. Appel's mistakes in allowing the patent application to become abandoned, allowing the patent application to remain abandoned, not notifying Mr. Sanatgar of the abandonment, and the details surrounding Mr. Appel's illness. (Id. at ¶¶ 4-6.)

Mr. Appel has avoided every opportunity to address the illness he suffered during the prosecution of the patent application. (Id. at ¶¶ 4, 5.) Instead, Mr. Appel has chosen to obfuscate his mistakes from the view of Thermal Dynamics, Mr. LaPorte, and the Patent Office. (Id. ¶ 7.) Overall, Mr. LaPorte made three written and several telephonic attempts to communicate with Mr. Appel. (Id. ¶¶ 3, 6, and 7.) Eventually, Mr. LaPorte had a meeting with Mr. Appel, however, Mr. Appel was uncooperative and would not meaningfully answer Mr. LaPorte's question with respect to why the '110 application was abandoned, why Mr. Appel would not provide the promised summary, and why he would not assist with the declaration for this renewed petition to revive. (Id. ¶¶ 3-7.) During that meeting, while Mr. Appel stated that he had been seriously ill, he would not provide details regarding his illness, other than stating he had two surgeries. (Id. at 5.) Mr. Appel also stated that if he reviewed his files he could more easily answer Mr. LaPorte's questions. Mr. LaPorte made several offers to assist Mr. Appel in reviewing his files, but Mr. Appel declined those offers. (Id.) Instead, Mr. Appel stated that he would review his files and provide Mr. LaPorte with a response by April 21, 2008. (Id.) Mr. Appel did not honor his promise, and has ceased communication with Mr. LaPorte despite numerous attempts to follow up with him. (Id.) Mr. LaPorte interpreted Mr. Appel's offer to

review his files a pretext for concluding the meeting. (Id. at ¶ 6.) A final letter was sent via mail to Mr. Appel on May 30, 2008, but Mr. Appel has not responded. (Id. at ¶ 7.) Having used all of the allowed time for filing the renewed petition, including the allowed extension of time under 37 C.F.R. 1.136(a), to seek Mr. Appel's cooperation, Applicant must now file this Renewed Petition.

Conclusion

Thermal Dynamics was diligent in every phase of the prosecution of the '110 patent application. Based on the foregoing, the attached declarations, and the attached Amendment and Response submitted on September 27, 2004 with the original petition for renewal, Petitioner respectfully submits that the present renewed petition should be granted and the application revived pursuant to 37 CFR § 1.137(b).

Respectfully submitted,

JONES DAY

By _____

Lawrence R. LaPorte
Reg. No. 38,948

Dated: July 18, 2008

555 South Flower Street, 50th Floor
Los Angeles, CA 90071
(213) 489-3939
LAI-2947944v3